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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,796	06/27/2003	Charles J. Doillon	14363	5886

293 7590 09/27/2006

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EXAMINER
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BLANCO, JAVIER G

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary  
for Applications  
Under Accelerated Examination**

Application No.

10/606,796

Applicant(s)

DOILLON ET AL.

Examiner

Javier G. Blanco

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Since this application has been granted special status under the accelerated examination program,  
NO extensions of time under 37 CFR 1.136(a) will be permitted and a **SHORTENED STATUTORY PERIOD FOR  
REPLY IS SET TO EXPIRE:**

**ONE MONTH OR THIRTY (30) DAYS, WHICHEVER IS LONGER,**  
FROM THE MAILING DATE OF THIS COMMUNICATION – if this is a non-final action or a *Quayle* action.  
(Examiner: For **FINAL** actions, please use PTOL-326.)

The objective of the accelerated examination program is to complete the examination of an application within twelve months from the filing date of the application. Any reply must be filed electronically via EFS-Web so that the papers will be expeditiously processed and considered. If the reply is not filed electronically via EFS-Web, the final disposition of the application may occur later than twelve months from the filing of the application.

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.  
2) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 3) ☒ Claim(s) 1-15 and 25-33 is/are pending in the application.  
3a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.  
4) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
5) ☐ Claim(s) \_\_\_\_\_ is/are rejected.  
6) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
7) ☒ Claim(s) 1-15 and 25-33 are subject to restriction and/or election requirement.

**Application Papers**

- 8) ☐ The specification is objected to by the Examiner.  
9) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
10) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 11) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicants' amendment of claims 1, 4, 25, and 26 in the reply filed on June 23, 2006 is acknowledged.
2. Applicants' cancellation of claims 16-24 in the reply filed on June 23, 2006 is acknowledged.
3. Applicants' addition of claims 28-33 in the reply filed on June 23, 2006 is acknowledged.

### ***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, 25, 26, and 29-33, drawn to a corneal implant comprising a hydrated membrane or a method for using said implant, classified in class 623, subclass 5.11.
  - II. Claims 27 and 28, drawn to a commercial package comprising a corneal implant, classified in class 264, subclass 1.7.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as

claimed because the membrane does not require to be hydrated. The subcombination has separate utility such as a corneal implant supplied (packaged) in a pre-hydrated state (i.e., there is no need for a re-hydration solution).

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:30 a.m.-7:00 p.m.), first Friday of the bi-week off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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Art Unit: 3738

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JGB

September 18, 2006

A large, stylized handwritten signature consisting of the letters 'J' and 'B' intertwined.A handwritten signature in cursive script, appearing to read 'David H. Willse'.

David H. Willse  
Primary Examiner